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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/065,282	09/30/2002	John F. Braun	F-522	5697

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EXAMINER
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NGUYEN, KIMNHUNG T

ART UNIT	PAPER NUMBER
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2674

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/065,282

**Applicant(s)**

BRAUN ET AL.

**Examiner**

Kimnhung Nguyen

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This Application has been examined. The claims 1-17 are pending. The examination results are as following.

Claims 18-20 are restricted by original claims.

1. Newly submitted claims 18-20 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: because the invention is directed to an augmented document comprising a digital pattern portion and input section.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 18-20 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-3, 5-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Lapstun et al. (US 6,681,045).

Regarding claim 1, Lapstun et al. discloses in figure 8, a method for associating metadata with a document having a metadata storage device attached to the document (see computer system having handwritten on a paper associate with identify and coded data, see column 2, lines 57-67) comprising initializing a pointing instrument (pen 101, figure 8); recognizing a metadata mode (see figure 49); capturing meta data using the pointing instrument (see handwritten on a paper) sending metadata to a processor; receiving metadata from the processor (see column 2, lines 20-34); and storing the metadata in the metadata storing device (see column 36, lines 5-10).

Regarding claim 2, Lapstun et al. discloses that receiving a process metadata command (see figure 38), wherein the pointing instrument is a digital pen (101, figure 8-9, 21).

Regarding claim 3, Lapstun et al. discloses that, wherein the metadata is penstroke data (884) captured from a predefined area of the document (see fig. 38, see col. 19, lines 43-45).

Regarding claims 5-6, Lapstun et al. discloses that wherein the metadata is pen stroke data captured from first subset or all pen strokes made on the document (see column 4, lines 53-57).

Regarding claim 7, Lapstun et al. discloses that wherein the metadata includes biometric data (see figure 21).

Regarding claim 8, Lapstun et al. discloses the method comprising storing an e-copy of the document strokes to the metadata storage (see print a copy of document, see column 25, lines 50-57).

Regarding claim 9, Lapstun et al. discloses the method of claim 2 wherein the metadata storage device comprises an integrated circuit (see col. 42, lines 12-31).

Regarding claim 10, Lapstun et al. discloses that the method of claim 1 wherein the document comprises a piece of paper (see page number, see fig. 56).

Regarding claim 11, Lapstun et al. discloses that wherein the document comprises a spiral bound book (see col. 48, lines 23-24).

Regarding claim 12, Lapstun et al. discloses that the method of claim 1 further comprising: cryptographically processing the metadata using authentication data (see col. 32, lines 40-46, and col. 19, lines 51-53).

Regarding claim 13, Lapstun et al. discloses that the method as discussed further comprising: discontinuing capturing metadata data after sufficient data to create a biometric signature is obtained (see fig. 21).

Regarding claim 14, Lapstun et al. discloses that wherein the metadata is a subset of the metadata data (see fig. 38).

Regarding claim 15, Lapstun et al. discloses that a method for associating metadata with a document having a metadata storage device comprising: receiving metadata data from a digital pen (see pen 101); processing the metadata data to determine a biometric signature; sending

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metadata to the digital pen including the biometric signature (see fig. 21, see col. 2, lines 57-67 and col. 366, lines 5-10).

Regarding claim 16, Lapstun et al. discloses that the method of claim 15, further comprising cryptographically processing the metadata (see col. 32, lines 40-46).

Regarding claim 17, Lapstun et al. discloses that wherein the metadata includes an e-copy representation of stroke data received from the digital pen ((see print a copy of document, see column 25, lines 50-57).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lapstun et al. (US 6,681,045) in view of Rekimoto et al. (US 6,795,060).

Lapstun et al. discloses every feature of the claimed invention, excluding wherein the metadata storage device is comprises an rf-id tag. Rekimoto et al. discloses in fig. 10, the storage device having rf-id tag, see abstract, see col. 15, lines 9-33). It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the using of the storage device having rf-id tag as taught by Rekimoto et al. into the system of Lapstun et al.

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because this would read identification data contained in each wireless tag and then activate a corresponding processing operation of the system.

***Response To Arguments***

6. Applicant's arguments with respect to claims 1-17 filed on 10/14/2004 have been considered but they are not persuasive.

Applicant argues that Lapstun et al. does not teach the storing the metadata in the metadata storage device. Examiner has disagreed with that because Lapstun et al. teaches the storing the metadata in the metadata storage device (see col. 36, lines 5-10). For these reasons, the rejections are maintained.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimnhung Nguyen whose telephone number is (571) 272-7698. The examiner can normally be reached on MON-FRI, FROM 8:30 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Edouard can be reached on (571) 272-7603. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kimnhung Nguyen  
May 2, 2005



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